

## **REMARKS**

Claims 1-39 are pending in the Application, and all stand rejected in the Office action mailed March 14, 2006. Claims 1, 17 and 32 are independent claims. Claims 2-16, 18-31 and 33-39 depend, respectively, from independent claims 1, 17 and 32. The Applicants respectfully request reconsideration of pending claims 1-39, in light of the following remarks.

### **Rejections of Claims**

#### **Non-Statutory Obviousness-Type Double Patenting Rejection**

Claims 1, 17 and 32 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 22 and 1, respectively, of co-pending Application No. 10/788,768 (hereinafter "Okkonen"). Applicants do not agree with the Examiner's rejection, but nevertheless are submitting a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(c), disclaiming the terminal part of this application that extends beyond the expiration date of any patent granted on commonly owned U.S. Patent Application No. 10/788,768, to obviate the double patenting rejection. Applicants respectfully submit that the obviousness-type double patenting rejection is overcome.

#### **Rejections Under 35 U.S.C. §103(a)**

Claims 1-7, 9-22 and 24-39 were rejected under 35 U.S.C. §103(a) as being unpatentable over US 2004/0031029 by Lee et al. (hereinafter "Lee"), in view of Bindu Rama Rao, U.S. Patent No. 6,941,453 (hereinafter "Rao"). The Applicants respectfully traverse the rejection.

The Applicants respectfully submit that the Examiner has failed to establish a case of prima facie obviousness for at least the reasons provided below. M.P.E.P. §2142 clearly states that "[t]he examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness." The M.P.E.P. §2142 goes on to state that "[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."

Applicants respectfully submit that M.P.E.P. §2141.01(I) states, in part, "...it must be known whether a patent or publication is in the prior art under 35 U.S.C. §102." The Applicants appreciate recognition in the Office action that Rao shares a common inventor with the Application, and that Rao constitutes prior art only under 35 U.S.C. §102(e). (Office action, page 6, item 13, lines 4-6) However, Applicant does not necessarily agree and specifically reserves the right to argue at a later date that Rao does not qualify as prior art under 35 U.S.C. §102(e).

**The Applicants respectfully submit that the Application and U.S. Patent No. 6,941,453 (Rao) were, at the time the invention of the Application was made, commonly owned by, or were subject to an obligation to assign to Bitfone Corporation.**

Applicants respectfully submit that, for the reasons set forth above, the Rao reference is disqualified as prior art under 35 U.S.C. §103(c), and that because Rao has been removed as a reference, a rejection of claims 1-7, 9-22 and 24-39 can no longer be valid. Therefore, Applicants respectfully request that the rejection of claims 1-7, 9-22 and 24-39 under 35 U.S.C. §103(a) be withdrawn.

Claims 8 and 23 were rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Rao, and further in view of Dan Kikinis (US Patent No. 5,708,776). The Applicants respectfully traverse the rejection.

The Applicants respectfully submit that claims 8 and 23 are dependent claims of independent claims 1 and 17, respectfully. Applicants believe that independent claims 1 and 17 are allowable over the proposed combination of references, for at least the reasons set forth above. Because claims 8 and 23 depend, respectfully, from claims 1 and 17, Applicants respectfully submit that dependent claims 8 and 23 are allowable over the proposed combination of references for at least the reasons set forth above with respect to claims 1 and 17, respectively.

Appln. No.: 10/807,694  
Reply to Office Action of March 14, 2006  
Response dated July 14, 2006

Applicants respectfully request, therefore, that the rejection of claims 8 and 23 under 35 U.S.C. 103(a) be withdrawn.

### **Conclusion**

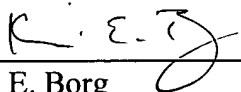
The Applicants believe that all of pending claims 1-39 are in condition for allowance. Should the Examiner disagree or have any questions regarding this submission, the Applicants invite the Examiner to telephone the undersigned at (312) 775-8000 to resolve any issues.

A Notice of Allowability is courteously solicited.

The Commissioner is hereby authorized to charge any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 13-0017.

Respectfully submitted,

Dated: July 14, 2006

  
\_\_\_\_\_  
Kevin E. Borg  
Reg. No. 51,486

McANDREWS, HELD & MALLOY, LTD.  
500 West Madison Street  
Suite 3400  
Chicago, Illinois 60661  
Phone (312) 775-8000  
Facsimile (312) 775-8100